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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,235	10/06/2005	Pierpaolo Zambotto	163-664	6366
47888 7590 02/09/2009 HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER				
PURDY, KYLE A				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
02/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/552,235

**Applicant(s)**

ZAMBOTTO ET AL.

**Examiner**

Kyle Purdy

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/06/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 2 pages (10/16/2005)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application***

1. Claims 1-16 are pending and claims 1-16 are presented for examination on the merits. The following rejections are made.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Objection to Claims, Allowable Subject Matter***

3. Claim 15 is objected to as being dependent upon a rejected base claim, but would likely be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Specification***

4. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/EP04/03310, filed 3/26/2004. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to

the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

5. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data

sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

***Improper Subject Matter (“Hybrid”/“Use” Claims)  
Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**7. Claim 16 provides for the use of ‘a composition according to claim 1 as a mouse- or rat-poisoning bait’, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass.**

8. A claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See MPEP 2173.05(q).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**11. Claims 1-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (US 5720951, published 02/24/1998) in view of Maruyama et al. (JP H02-149501, published 11/30/1988, abstract relied upon) and Endepols et al. (US 2005/0181003, filed 04/24/2003).**

12. Baker is directed to rodenticide bait. The bait comprises a mixture of ground cereal like ground wheat (a crop powder), icing sugar (refined sugar), an oil (vegetable oil such as peanut oil), triethanolamine, a preservative, a bittering agent such as denatonium benzoate and a rodenticide such as brodifacoum (see Examples 1-4; see instant claims 1-13). It's also taught that the composition may comprise saccharin as a palatability enhancing agent (see column 4, line 5). Other exemplified rodenticidal compounds include that of warfarin (see column 4, line 25; see instant claims 11 and 12). A method is taught for feeding the bait to rodents to cause them to die (see Examples 8-10; see instant claim 16).

13. Baker fails to teach the composition as being in the form of a paste. Baker also fails to teach the vegetable oil as being coconut or palm oil and the ground flour as being superfine.

14. Maruyama is directed to a bait for rodents comprising a rodenticide such as warfarin (see instant claims 11 and 12). The bait is a mixture of oils and crop powder. Exemplified oils include coconut and palm oils (see instant claims 1-7).

15. Endepols is directed to making products for killing harmful rodents (see abstract). The rodenticide products are to be in the form of a paste. Paste according to Endepols is a combination of ground cereals and vegetable oils (see [0002]). It is taught that pastes are preferred because of their superior palatability to the rodent and minimize the chances of non-target animals eating the bait (see [0006]). Moreover, bait pastes are useful for killing rodents because a paste may be shaped, have improved consistency over dry bait, and remains attractive to rodents over long periods of time and does not cure over long periods of time (see [0011]; see instant claim 1).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Baker and Maruyama and Endepols with a reasonable expectation for success in arriving at a rodenticidal composition in the form of a paste which comprises a fraction of carbohydrate and fatty matter both prevalently of vegetable origin. Baker teaches a bait composition which uses a carbohydrate and fat source solely from a vegetable origin. Although Baker does not include palm or coconut oil in their product, one of ordinary skill in the art would have readily done such. Maruyama is directed to rodenticidal composition which comprises a rodenticide, crop powder and a vegetable oil. Exemplified vegetable oils include palm, coconut and peanuts oils. One of ordinary skill would have recognized that vegetable oils in rodent bait are functionally equivalent and interchangeable and would endeavor to use any vegetable oil known at the time. Thus, if one were to modify the

teaching of Baker such that it used coconut or palm oil rather than peanut oil, then this would have been a product of ordinary skill and common sense. It is not considered inventive to substitute out one known ingredient for another functionally identical ingredient. With respect to the requirement that the iodine index be between 48-53, this would have necessarily been the case if one were to modify the teaching of Baker with Maruyama. The mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd.Pat. App. & Inter. 1985). With respect to the requirement that the bait be in the form of a paste, this would have been an obvious modification to composition of Baker. Paste, according to Endepols, is a preferred form because it can be shaped and molded and remains attractive to rodents after long periods of time. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

**17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (US 5720951, published 02/24/1998) in view of Maruyama et al. (JP H02-049501, published 11/30/1988, abstract relied upon) and Endepols et al. (US 2005/0181003, filed 04/24/2003) as applied to claims 1-13 above, and further in view of Aeschlimann (US 1858177, published 05/10/1932).**

18. Baker, Maruyama and Endepols fail to teach the composition comprising ground biscuit.



19. Aeschlimann is directed to a product for destroying animals such as rodents and rabbits. It's taught that useful bait is pastry. An exemplified pastry is powdered biscuit and is suggested as a useful means for attracting rodents (see column 2, lines 70-75; see instant claim 14).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Baker, Maruyama, Endopols and Aeschlimann with a reasonable expectation for success in arriving at a bait composition which comprises ground biscuit. One would have been motivated to include powdered biscuit into the combination of above references as it would add an additional feature for attracting rodents to the bait. Moreover, if a component such a ground biscuit is added to a composition to improve the compositions attractiveness to rodents, a person of ordinary skill in the art would recognize that its addition would improve other rodent bait compositions in the same way. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

### ***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/  
Examiner, Art Unit 1611  
January 29, 2009*

*/David J Blanchard/  
Primary Examiner, Art Unit 1643*